

C. APPLICANT'S COMMENTS

Claims 1-11 are pending in this Application, with Claims 1, 2, 8, 9, 11 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-11 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The Specification was objected to as having an Abstract exceeding 150 words. The Applicant has amended the Abstract to be less than 150 words in accordance with the Examiner's helpful suggestion and requests that the objection be withdrawn.

Paragraph 2 of the Office Action

Claims 1-11 were objected to due to minor informalities. The Applicant has amended the claims in accordance with the Examiner's helpful suggestions and requests that the objection be withdrawn.

Paragraph 3 of the Office Action

Claims 1-11 were rejected for various minor defects. The Applicant has amended the claims in accordance with the Examiner's helpful suggestions and requests that the rejection be withdrawn.

Paragraph 4 of the Official Action

The Official Action rejected Claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over **Tetro et al.** (U.S. Patent No. 6,122,624). The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*,

26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Claim 1 (as amended) has the following features:

1. (Currently Amended) A method of client account access protection for client/server or brick and mortar based transactions comprising:
storing client defined access parameters input by a client, wherein said client defined access parameters define parameters that must be satisfied before a transaction of funds or information is authorized;
initiating a transaction of funds or information;
requesting account holder private information;
entering said account holder private information;
gathering other gathered information;
comparing said account holder private information along with said other gathered information with said client defined access parameters; and
determining to authorize or deny said transaction.

Claim 2 (as amended) has the following features:

2. (Currently Amended) A method according to claim 1 where said client defined access parameters is any one or combination comprised of:
a password;

client accounts selected enabled or denied by the client for said transaction;
merchants selected enabled or denied for transaction with client accounts by the client;
geographic location parameters selected for association with a client account and merchants by the client where said transaction is allowed to occur;
a **monetary amount** associated with each account and merchant to limit the total amount of a single or a selected number of subsequent transactions;
a selection by the client to **enable or deny access to the client accounts transacted through a bricks and mortar establishment and/or a network connection**.

Claim 9 (as amended) has the following features:

9. (Currently Amended) A method according to claim 1 where said other gathered information comprises **the location, date or time of said entering said account holder private information for said transaction**.

Claim 10 (as amended) has the following features:

10. (Currently Amended) A method according to claim 1 where said determining to authorize or deny the transaction comprises:
authorizing said transaction if requested private client information and said other gathered information matches said client defined access parameters; and
denying said transaction if the requested private client information and said other gathered information does not match said client defined access parameters.

Tetro merely teaches the usage of non-changeable parameters such as “the user’s billing address and social security number” for verifying a purchase to prevent fraud. While Tetro has a similar purpose as the present invention (i.e. to prevent purchase fraud), Tetro performs the task on the vendor side ... not the consumer side. In Tetro, the “vendor” determines the “predetermined threshold amount” that an account can be charged – not the “consumer” as with the present invention. (Column 5, Lines 28-48 of Tetro.)

In particular, Tetro does not show the features as contained in Claims 1, 2, 9 and 10 (illustrated above). For example, Tetro does not teach or suggest “**storing client defined access parameters input by a client, wherein said client defined access parameters define parameters that must be satisfied before a transaction of funds or information is authorized.**” (Claim 1.) In addition, Tetro does not teach or suggest “**requesting account holder private information.**” (Claim 1.) Also, Tetro does not teach or suggest “**gathering**

other gathered information.” (Claim 1.)¹ Furthermore, Tetro does not teach or suggest “comparing said account holder private information along with said other gathered information with said client defined access parameters.” (Claim 1.) Finally, Tetro does not teach or suggest “authorizing said transaction if requested private client information and said other gathered information matches said client defined access parameters; and denying said transaction if the requested private client information and said other gathered information does not match said client defined access parameters.” (Claim 10.)

Regarding Claim 2, Tetro does not teach or suggest client defined access parameters that include a password. (Claim 2.) Also, Tetro does not teach or suggest client defined access parameters that include “client accounts selected enabled or denied by the client for said transaction.” (Claim 2.) Also, Tetro does not teach or suggest client defined access parameters that include “merchants selected enabled or denied for transaction with client accounts by the client.” Also, Tetro does not teach or suggest client defined access parameters that include “geographic location parameters selected for association with a client account and merchants by the client where said transaction is allowed to occur.” (Claim 2.) In addition, Tetro does not teach or suggest client defined access parameters that include “a monetary amount associated with each account and merchant to limit the total amount of a single or a selected number of subsequent transactions.” (Claim 2.) Finally, Tetro does not teach or suggest client defined access parameters that include “selection by the client to enable or deny access to the client accounts transacted through a bricks and mortar establishment and/or a network connection.”

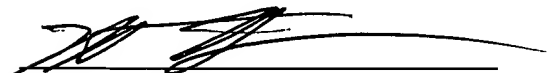
All of the above features contained in amended Claims 1, 2, 9 and 10 are important for the proper operation of the present invention as intended. For these reasons, among others Tetrao cannot suggest the combination of features in applicant’s Claims 1-11, particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-11 allowed.

¹ This is particularly true with the features shown in Claim 9 further defining the “other gather information” as “the location, date or time of said entering requested account holder private information for said transaction.”

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,


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August 29, 2005

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